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Filing date: **04/06/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223497
Party	Defendant Buglisi Recobs Group LLC
Correspondence Address	PATRICK C O'REILLY LIPSITZ GREEN SCIME CAMBRIA LLP 42 DELAWARE AVENUE, SUITE 120 BUFFALO, NY 14202 UNITED STATES poreilly@lglaw.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Patrick C. O'Reilly
Filer's e-mail	poreilly@lglaw.com
Signature	/Patrick C. O'Reilly/
Date	04/06/2016
Attachments	NOTICE OF MOTION TO AMEND ANSWER-Scan.pdf(1442741 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Respondent: BUGLISI RECOBS GROUP LLC
Application No.: 86415114
Mark: MISTER GINGER

JIM BEAM BRANDS CO.,

Opposer

v.

BUGLISI RECOBS GROUP LLC,

Applicant

**NOTICE OF MOTION FOR
LEAVE TO AMEND ANSWER**

**Opposition No. 91223497
Serial No. 86/415,114**

PLEASE TAKE NOTICE, that a motion will be made for the relief specified herein in connection with the above-entitled action as follows:

MOVING PARTY: Applicant, BUGLISI RECOBS GROUP, LLC

PLACE: **PATENT AND TRADEMARK OFFICE**

**RELIEF SOUGHT AND
GROUNDS THEREFORE:** An Order granting Applicant leave to serve and file an amended answer with counterclaim to Opposer's Notice of Opposition, together with Any further relief the Board deems just and property. Fed. R. Civ. Proc. 15(a), 13(e).

SUPPORTING PAPERS: This Notice of Motion, Affidavit of Patrick C. O'Reilly, Esq., the Affidavit of Joshua Recobs

DATED: Buffalo, NY
March 17, 2016

LIPSITZ GREEN SCIME CAMBRIA, LLP


PATRICK C. O'REILLY, ESQ.

Attorneys for Applicant
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Chicago, IL 60601

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Respondent: BUGLISI RECOBS GROUP LLC
Application No.: 86415114
Mark: MISTER GINGER

JIM BEAM BRANDS CO.,

Opposer

v.

BUGLISI RECOBS GROUP LLC,

Applicant

AFFIRMATION

Opposition No. 91223497

Serial No. 86/415,114

PATRICK C. O'REILLY, ESQ., being duly sworn, deposes and says:

1. I am the attorney of record for the co-Applicant, Buglisi Recobs Group, KKC in the above entitled opposition action and submit this affirmation in support of Applicant's Notice of Motion for leave to amend its answer to opposer's Notice of Opposition.
2. On October 2, 2015, Applicant filed an answer to the Notice of Opposition. A copy of that Answer is annexed hereto as Exhibit A.
3. Subsequent to the filing of the Answer, research revealed that "Opposer", Jim Beam Brands Co. had previously filed a formal written response to an Office Action issued February 28, 2011 in connection with Opposer's Application to register "2 GINGERS," the primary mark upon which Opposer relies in the instant action.
4. The said Office Action requested that Opposer disclaim the term "Ginger" and "Gingers."
5. A review of that Response, a copy of which is annexed hereto as Exhibit B, revealed that Opposer in the Office Action made statements of fact and law which are contrary to the position taken by Opposer in the instant opposition action.
6. Annexed hereto as Exhibit C is a proposed Amended Answer with Counterclaim which Plaintiff seeks leave to file and serve pursuant to Fed. R. Civ. P. roc 15.

7. The proposed amendment adds just two new components to the pleading:

(i) The amended pleading contains an additional affirmative defense seeking to estopp Opposer from taking any legal positions or averring any facts contrary to those previously submitted to the Trademark Trial and Appeal Board by Opposer; and

(ii) The amended pleading adds a counterclaim, pled in the alternative, which seeks a cancellation of Opposer's marks which cancellation would make the instant opposition action moot.

8. It is submitted that Opposer cannot be prejudiced by such an amendment since the only facts alleged and legal theories contained therein are those previously addressed by the Opposer in its written response to the Office Action issued on February 28, 2011.

9. Moreover, I note that, in any event, discovery is not closed.

10. In contrast, it is submitted that a denial of leave to amend would severely and unfairly prejudice Applicant in that it would foreclose Applicant from compliance with the compulsory counterclaim rule, T.M.R.P. 2.106(b) and 2.114(b), and could unjustly preclude Applicant from arguing facts and law previously submitted to the Board by Opposer in a related action.

11. The probative significance of the statements and admissions contained in Opposer's response to the 2011 Office Action is demonstrated in the quotes contained within Applicant's proposed Amended Answer with Counterclaim [see Exhibit C at paragraphs 32(a)-(m)].

WHEREFORE, your deponent respectfully requests that the Board grant the relief requested in the annexed Notice of Motion.

Dated: March 19, 2016



Patrick C. O'Reilly

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Respondent: BUGLISI RECOBS GROUP LLC
Application No.: 86415114
Mark: MISTER GINGER

JIM BEAM BRANDS CO.,

Opposer

v.

BUGLISI RECOBS GROUP LLC,

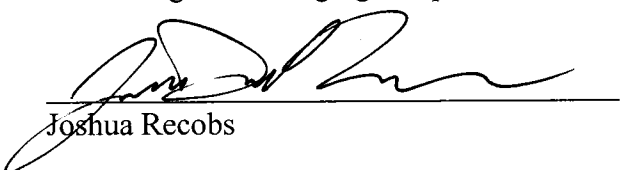
Applicant

AFFIDAVIT

**Opposition No. 91223497
Serial No. 86/415,114**

JOSHUA RECOBS, being duly sworn, deposes and says:

1. I am a principal owner of Applicant Buglisi Recobs Group, LLC and have personal knowledge of the facts and circumstances set forth herein.
2. The product to be marketed under the trademark "Mister Ginger," if registration is permitted, is a ginger flavored whiskey beverage.
3. The product is not a straight whiskey, or a "whiskey" per se, as said terms are defined by law.
4. The product is not an "Irish whiskey," nor does it contain any Irish whiskey whatsoever.
5. The use of the term "ginger" within the proposed trademark is descriptive and my attorney has heretofore communicated Buglisi Recobs Group, LLC's willingness to disclaim the term "ginger" and make no claim as to the exclusive right to use "ginger" apart from the trademark "Mister Ginger."


Joshua Recobs

Sworn to before me this
23rd day of March, 2016


Notary Public

KATHLEEN A. BADDING NO. 01BA6077717
NOTARY PUBLIC, STATE OF NEW YORK
QUALIFIED IN ERIE COUNTY
MY COMMISSION EXPIRES JULY 15, 2018

EXHIBIT A

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Respondent: BUGLISI RECOBS GROUP LLC
Application No.: 86415114
Mark: MISTER GINGER

JIM BEAM BRANDS CO.,

Opposer

v.

BUGLISI RECOBS GROUP LLC,

Applicant

ANSWER

Opposition No. 91223497
Serial No. 86/415,114

Applicant BUGLISI RECOBS GROUP, LLC ("Respondent" or "BRG"), in response to the opposition filed by Opposer JIM BEAM BRANDS CO. ("Opposer") (the "Opposition"), by and through its undersigned counsel hereby answers the Opposition as follows:

ANSWER

1. Responding to paragraph 1 of the Opposition, BRG admits that it is a limited liability company, and admits that it is located at 189 Montclair Avenue, Montclair, New Jersey 07042.

2. Responding to paragraph 2 of the Opposition, BRG admits that on October 5, 2014, it filed Application Serial No. 86/415,114 (the "Application") for the mark "MISTER GINGER" ("Applicant's Mark") for the "alcoholic beverages, namely, flavor-infused whiskey; blended whisky; bourbon whisky; malt whisky; whiskey; whisky," on an intent to use basis.

3. Responding to paragraph 3 of the Opposition, BRG is without knowledge or information to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

1 4. Responding to paragraph 4 of the Opposition, BRG is without knowledge or information
2 to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

3 5. Responding to paragraph 5 of the Opposition, BRG is without knowledge or information
4 to form a belief as to the truth of the allegations contained therein.

5 6. Responding to paragraph 6 of the Opposition, BRG is without knowledge or information
6 to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

7 7. Responding to paragraph 7 of the Opposition, BRG admits that it filed its "MISTER
8 GINGER" mark on October 5, 2014, on an intent to use basis, subject to the clarification that the
9 application for registration included "flavor-infused whiskey; blended whisky; bourbon whisky;
10 malt whisky; whiskey; whisky."
11

12 8. Responding to paragraph 8 of the Opposition, BRG is without knowledge or information
13 to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

14 9. Responding to paragraph 9 of the Opposition, BRG admits that it does not currently use
15 the "MISTER GINGER" mark in connection with the goods for which it seeks registration; admits
16 that the business appears to still be in the development phase; denies that Exhibit C is a true and
17 correct copy of the Applicant's website, www.buglisirecobsgroup.com, at the present date.
18

19 10. BRG denies the allegations contained in paragraph 10 of the Opposition.
20

21 11. BRG denies the allegations contained in paragraph 11 of the Opposition.
22

23 12. BRG denies the allegations contained in paragraph 12 of the Opposition.
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25 13. BRG denies the allegations contained in paragraph 13 of the Opposition.
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Opposer's Prayer for Relief

BRG denies that Opposer is entitled to any of the relief requested in its prayer for relief.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

14. As and for a separate Affirmative Defense, Applicant BRG alleges that the Opposition fails to state facts sufficient to constitute a cause of action against BRG and upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

15. As and for a separate Affirmative Defense, Applicant BRG alleges that there is no likelihood of confusion, mistake, or deception between BRG's mark and Opposer's alleged trademark as to association, connection, sponsorship, endorsement, or approval of Opposer.

THIRD AFFIRMATIVE DEFENSE

16. Opposer does not have trademark rights in MISTER GINGER.

FOURTH AFFIRMATIVE DEFENSE

17. As and for a separate Affirmative Defense, Opposer lacks standing to bring one or more of the claims alleged against Applicant BRG.

FIFTH AFFIRMATIVE DEFENSE

18. As and for a separate Affirmative Defense, Applicant BRG alleges that the Opposition is uncertain, ambiguous, and unintelligible.

SIXTH AFFIRMATIVE DEFENSE

19. As and for a separate Affirmative Defense, Applicant BRG alleges that it has suffered damage by reason of Opposer's conduct.

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SEVENTH AFFIRMATIVE DEFENSE

20. As and for a separate Affirmative Defense, Applicant BRG alleges that it will not infringe, has not infringed, does not infringe (either directly or indirectly), and will not become liable for any purported trademark rights of Opposer.

EIGHTH AFFIRMATIVE DEFENSE

21. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because the trademark registrations and any derivative claims of infringement, separately and collectively, constitute misuses of the trademarks and misapplication of the law and statutes on which they are based.

NINTH AFFIRMATIVE DEFENSE

22. As and for a separate Affirmative Defense, Opposer's claims are barred to the extent that Opposer claims rights to elements of its products that are not protectable by trademark.

TENTH AFFIRMATIVE DEFENSE

23. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because the allegedly protectable features or characteristics of the subject trademark are functional.

ELEVENTH AFFIRMATIVE DEFENSE

24. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because any alleged association with Opposer's trademark rights is *de minimus*.

TWELFTH AFFIRMATIVE DEFENSE

25. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because there is virtually no similarity in the products offered, no associated commercial impression, and the marks apply wholly distinct connotations to the word GINGER.

THIRTEENTH AFFIRMATIVE DEFENSE

1 26. As and for a separate Affirmative Defense, Opposer has no claim of priority of use in the
2 MISTER GINGER mark in connection with any products, let alone "flavor-infused whiskey;
3 blended whisky; bourbon whisky; malt whisky; whiskey; whisky."

4 WHEREFORE, Applicant BRG requests the judgment of this Court that it deny the
5 Opposition against it, grant registration of Application Serial No. 86/415,114, and award
6 Applicant BRG its costs in defending this action, together with its reasonable attorneys' fees, and
7 such other and further relief as this Court deems just and equitable.
8

9 DATED: October 2, 2015

10 Respectfully submitted,

11 BUGLISI RECOBS GROUP LLC, by its counsel
12 LIPSITZ GREEN SCIME CAMBRIA LLP

13 /Patrick O'Reilly/
14 Patrick C. O'Reilly, Esq.
15 42 Delaware Avenue, Suite 120
16 Buffalo, New York 14202
17 (716) 849-1333 ext. 363
18 Facsimile: (716) 849 - 1315
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EXHIBIT B

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/30/2011)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85199355
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
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RESPONSE SIGNATURE	/Renee S. Kraft/
SIGNATORY'S NAME	Renee S. Kraft
SIGNATORY'S POSITION	Attorney of Record, Minnesota State Bar Member
DATE SIGNED	08/26/2011
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Aug 26 18:07:06 EDT 2011
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XX-2 0110826180706026275-85199 355-480ad3658c504fa9e0f75 015a45362d496-N/A-N/A-201 10826172647669009

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/30/2011)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **85199355** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of arguments and evidence in support of arguments has been attached.

Original PDF file:

evi 3810419662-172647669 . 2 GINGERS ARGUMENTS.pdf

Converted PDF file(s) (8 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Original PDF file:

evi 3810419662-172647669 . 2 GINGERS EXHIBIT A.pdf

Converted PDF file(s) (1 page)

Evidence-1

Original PDF file:

evi 3810419662-172647669 . 2 GINGERS EXHIBIT B.pdf

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Evidence-1

Original PDF file:

evi 3810419662-172647669 . 2 GINGERS EXHIBIT C.pdf

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Evidence-1

Evidence-2

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evi 3810419662-172647669 . 2 GINGERS EXHIBIT D.pdf

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Evidence-1

Evidence-2

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Evidence-1

Evidence-2

Evidence-3

Original PDF file:

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Converted PDF file(s) (2 pages)

Evidence-1

Evidence-2

Original PDF file:

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Evidence-1

Original PDF file:

evi 3810419662-172647669 . 2 GINGERS EXHIBIT H.pdf

Converted PDF file(s) (1 page)

Evidence-1

SIGNATURE(S)

Response Signature

Signature: /Renee S. Kraft/ Date: 08/26/2011

Signatory's Name: Renee S. Kraft

Signatory's Position: Attorney of Record, Minnesota State Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 85199355

Internet Transmission Date: Fri Aug 26 18:07:06 EDT 2011

TEAS Stamp: USPTO/ROA-XX.XXX.XXX.XX-2011082618070602

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RESPONSE – 2 GINGERS SN: 85/199,355

Applicant submits this Response in response to the Office Action issued on February 28, 2011 in connection with Applicant's application to register the mark 2 GINGERS ("Applicant's Mark") for whiskey.

REQUIREMENT TO DISCLAIM "GINGERS"

The Examining Attorney has requested that Applicant disclaim the word "GINGERS" in Applicant's mark because the Examining Attorney believes it is merely descriptive of Applicant's goods. Applicant respectfully disagrees and submits that the word "GINGERS" has absolutely no descriptive meaning in connection with Applicant's whiskey.

A term is considered descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods. T.M.E.P. §1209.01(b). Suggestive marks are those that "require imagination, thought, or perception to reach a conclusion as to the nature of the goods or services." *See* T.M.E.P. § 1209.01(a). If a term in a mark "imparts information directly it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive." *Platinum Home Mortgage Corp. v. Platinum Financial Group, Inc.*, 149 F.3d 722, 47 U.S.P.Q.2d 1587 (7th Cir. 1998) (quoting *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947 (7th Cir. 1992)). Doubts concerning the descriptiveness of a mark should be resolved in favor of the Applicant during ex parte prosecution. *See In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972) (THE LONG ONE for bread held not descriptive).

The Examining Attorney stated that the word "GINGERS" is "commonly used to describe a flavor of whiskey or ingredient in whiskey." That is not the case. The Examining Attorney appears to base this assertion on a few isolated Internet websites that provide instructions for *infusing* various types of alcohol and one reference to a Canadian spiced

whisky¹. The term “GINGER” or “GINGERS” is not descriptive of an ingredient or flavor of Applicant’s goods because: (1) Applicant’s whiskey does not contain ginger and is not ginger flavored; (2) the term “GINGERS” is not commonly used to describe whiskey (in fact, based on government regulations, whiskey cannot contain flavor additives such as ginger); and (3) Applicant selected Applicant’s Mark to be arbitrary or suggestive. As such, the term “GINGERS” cannot be descriptive of an ingredient or flavor of whiskey. Based on the foregoing, Applicant respectfully requests that the Examining Attorney remove the disclaimer requirement.

A. Applicant’s mark is arbitrary and fanciful

Applicant’s Mark “2 GINGERS” is a coined term that was created to tell the fictional branding story of two imaginary red-haired Irish women known for their lively and hospitable character. *See* Exhibit A – a true and correct copy of a label affixed to Applicant’s whiskey that tells this story. Applicant’s Mark is derived from and meant to connote words, phrases, the culture and images commonly associated with Ireland, the country where Applicant’s whiskey is distilled. In Ireland and elsewhere, people who have red hair are commonly referred to as “gingers.” *See* Exhibit B, a true and correct copy of a printout from Merriam-Webster’s online dictionary defining the word “ginger.”

As depicted on Applicant’s label, it is clear that Applicant’s 2 GINGERS mark refers to two fictional Irish women with red hair. However, even when the 2 GINGERS word mark used on its own and apart from the label, consumers are likely to associate the term “GINGERS” in Applicant’s Mark with people who have red hair, and not to ginger flavoring or to a ginger root. The word “ginger” when used to refer to the flavor of ginger or to a ginger root is always used in

¹ There are four main types of whiskey sold in the U.S. – American, Canadian, Irish and Scotch. American and Irish whiskey is spelled with an “ey.” Canadian and Scotch whisky is spelled with a “y.”

the singular form – even when referring to a given quantity of ginger. For example, someone might say, “please pick up 3 ginger roots at the grocery store,” or “this recipe calls for 4 teaspoons of ground ginger.” It would not be proper to say “give me 2 gingers from the cupboard.” On the other hand, the word “ginger,” when used to refer to people with red hair, is often used in the plural form. One might say, “there are a lot of gingers in Ireland” or “she comes from a long line of gingers.” Accordingly, based on common usage, a person encountering Applicant’s Mark would assume that the word “GINGERS” refers to people with red hair and not to ginger flavoring. This is particularly true because Applicant’s whiskey is an Irish whiskey, and, as noted above, the term “GINGERS” is often associated with red-haired people from Ireland.

Applicant’s Mark connotes a second meaning that also has its roots in Irish culture. The phrase “ginger-up” is an Irish phrase that refers to something that makes people or things more lively. *See* Exhibit C – a true and correct copy of a printout from thefreedictionary.com defining the phrase “ginger up.” *See also* Exhibit D – a printout from Applicant’s Facebook page describing the meaning behind applicant’s use of the word “GINGERS” in Applicant’s mark. When used in connection with Applicant’s goods, the term “GINGERS” hints at both the Irish background of Applicant’s whiskey and encourages lively conversation.

Based on the foregoing, it is clear that Applicant’s Mark is arbitrary or suggestive of Applicant’s goods. Consumers who encounter Applicant’s mark will view the term “GINGERS” as being suggestive of Irish people and culture and to the good times that can be had while enjoying whiskey.

B. “GINGERS” is not descriptive of whiskey

- 1. “Whiskey,” by law and definition, cannot be made with ginger as an ingredient, therefore “GINGERS” cannot be descriptive of whiskey.**

Consumers of Applicant’s whiskey are also very unlikely to ascribe any descriptive meaning to Applicant’s use of the term “GINGERS” in Applicant’s mark because “whiskey” does not contain ginger or ginger flavoring. Significantly, the addition of such flavoring to whiskey is not permitted under U.S. law (or Irish law, for that matter).

Whiskey is “a liquor distilled from fermented wort (as that obtained from rye, corn, or barley mash).” *See* Exhibit E – A true and correct copy of a printout from Merriam-Webster’s online dictionary defining the word “whiskey.” Pursuant to 27 C.F.R. §5.22, whiskey is legally defined as an “alcoholic distillate from a fermented mash of grain produced at less than 190° proof in such manner that the distillate possesses the taste, aroma, and characteristics generally attributed to whisky, stored in oak containers . . . and bottled at not less than 80° proof.” 27 C.F.R. § 5.22 (b). Irish whiskey must also be a product of Ireland, manufactured either in the Republic of Ireland or in Northern Ireland, in compliance with Irish laws regulating the manufacture of Irish Whiskey. 27 C.F.R. § 5.22 (b)(8). The Irish laws regarding what constitutes whiskey are substantially similar to those set forth above regarding whiskey under U.S. laws. *See* Exhibit F – a true and correct copy of the Irish Whiskey Act of 1980. Although 27 C.F.R. § 5.23 (a)(2) allows for the addition “harmless” coloring, flavoring and blended materials to certain distilled spirits, “‘harmless coloring, flavoring, and blended materials’ shall not include . . . any material whatsoever in the case of neutral spirits or straight whiskey.” 27 C.F.R. § 5.23 (a)(3)(iii). Furthermore, U.S. law specifies that “the addition of any coloring, flavoring, or blending materials to any class and type of distilled spirits . . . alters the class and type thereof and the product shall be appropriately redesignated.” 27 C.F.R. § 5.23 (a)(1).

Accordingly, whiskeys that contain coloring, flavoring or other blended materials are no longer considered “whiskey” under U.S. law. Instead, such spirits are classified as “flavored whiskey” and must be labeled as such. *See* 27 C.F.R. § 5.22 (j).

The distinction between “whiskey” and “flavored whiskey” is further supported by the Trademark Office’s ID Manual, which calls for whiskey to be identified as either “whiskey” or “alcoholic beverages, namely, flavor-infused whiskey.” *See* Exhibit G – A true and correct printout from the Trademark Office ID Manual showing classifications for “whiskey” and “flavor-infused whiskey.” Accordingly, while ginger may be descriptive of ginger-infused alcoholic beverages, it is not descriptive of Applicant’s whiskey.

2. The Examining Attorney has presented no evidence that consumers believe “ginger” (much less “GINGERS”) is descriptive of whiskey.

There is no evidence that consumers refer to or believe “ginger,” much less “GINGERS,” is descriptive of whiskey.²

3. The Examining Attorney has presented no evidence that the relevant industry uses – or needs to use – “ginger” (much less “GINGERS”) descriptively for whiskey.

There is no evidence that the industry involved in the manufacture, distribution or sale of whiskey uses the term “ginger,” much less “GINGERS,” descriptively or believes the term to be descriptive. The only evidence presented from the industry is a single off-the-shelf Canadian whisky containing ginger called Revel Stoke flavor-infused whisky. In line with the above-referenced distinction between whiskey and flavor-infused whiskey, it is important to note that

² Consumers of Applicant’s goods are sophisticated purchasers and would know the difference between whiskey and a flavor-infused whiskey. While whiskey can be used in mixed drinks, it is very flavorful and often enjoyed on its own – either straight up or on the rocks. Whiskey is a complex alcoholic beverage, that has a very distinctive flavor depending on where the whiskey is distilled. For example, Irish whiskey tends to be sweeter than Scotch whisky. Accordingly, people who purchase whiskey are very mindful of the distilling process and location of the distillery when deciding which whiskey to purchase. Consumers of Applicant’s goods are very selective and conscientious when making purchasing decisions. They would quickly note the difference between a whiskey and a flavor-infused whiskey. In particular, they would recognize that Applicant’s whiskey does not contain any added flavoring and, therefore, would never ascribe a descriptive meaning to the term “GINGERS” in Applicant’s Mark.

Revel Stoke clearly advertises and labels its product as being a “spiced whisky.” *See* Exhibit H – a true and correct copy of a printout from revelstokewhisky.com showing the labeling for Revel Stoke spiced whisky. Because Revel Stoke is a spiced Canadian flavored-whisky, this reference does not show use of ginger flavoring in connection with Applicant’s goods, namely, whiskey.

Furthermore, this evidence does not support a finding of descriptiveness for several reasons:

- (1) Revel Stoke is a “flavored-whisky” not a “whisky”;
- (2) there is no evidence that it is sold in the U.S. (or if it is, whether it is sold in sufficient quantities to impact consumer perceptions); and
- (3) it is only one reference out of the many whiskies/whiskeys/flavored-whiskeys in existence.

Applicant submits that the term “GINGERS” is not commonly used in the alcohol industry to refer to whiskey. In fact, according to the common dictionary definition and legal standards supplied by Applicant, the term “GINGERS” has no descriptive meaning, and can have no descriptive meaning, in connection with whiskey. The absence of a term from published materials supports a finding of non-descriptiveness. *Coca-Cola Co. v. Seven-Up Co.*, 497 F.2d 1351, 1353 (C.C.P.A. 1974). Even if the term “GINGERS” was a descriptive term in the alcohol industry, it would not describe, let alone “merely describe,” Applicant’s goods because Applicant’s goods are neither ginger-flavored nor infused with ginger and whiskey never can be ginger-flavored or infused with ginger.

Moreover, the use of the term “GINGERS” in Applicant’s Mark does not preclude the use of ordinary descriptive terms needed by competitors to properly describe their own goods. *See In re Pennwalt Corporation*, 173 U.S.P.Q. 317 (T.T.A.B. 1972), *The Fleetwood Company v. Mitchem Company*, 139 U.S.P.Q. 116 (C.C.P.A. 1963), *In re Sunbeam Corporation*, 152

U.S.P.Q. 116 (C.C.P.A. 1967). The public policy behind the descriptiveness doctrine is intended to ensure that there is no competitive need for a term in the marketplace. While Applicant uses the term “GINGERS” to specifically identify itself as the source of its whiskey, competitors have a virtually limitless number of merely descriptive words to truthfully describe their own goods, including, among others, “whiskey,” “distilled spirits,” “flavor-infused whiskey.”

4. The fact that ginger can be added or infused into alcohol does not make “GINGERS” descriptive of whiskey.

The only other evidence provided by the Examining Attorney are some references to instructions for how to infuse alcohol with various flavors. All of the instructions for infusing whiskey say to first purchase a bottle of whiskey, which is, by definition, free from infused flavoring. As such, these references do not refer to any ginger-flavored whiskeys sold to consumers. Instead, they refer to purely homemade concoctions. Even if sold in stores, these flavored drinks would be classified as flavor-infused or spiced whiskeys, and not whiskey.

Any liquid or flavor can be used to infuse alcohol. That does not, however, mean that terms used to describe those flavors are also descriptive of alcohol. Applicant respectfully submits that the mere fact that ginger flavoring can be used to infuse whiskey does not indicate that the term “GINGERS” is descriptive when used in connection with Applicant’s whiskey. Flavor-infused whiskey is not the same thing as whiskey. They are two different and distinct products, and are as unrelated as wine and wine coolers or vodka and gin. The term “GINGERS” simply does not describe Applicant’s goods, let alone immediately tell consumers something about them.

As a result of the foregoing, Applicant respectfully submits that the T.M.E.P., case law, Office records, U.S. (and Irish) whiskey regulations, and the Examining Attorney’s own marketplace evidence indicate that the term “GINGERS” is arbitrary or suggestive of

Applicant's goods. Therefore, Applicant respectfully requests the Examining Attorney withdraw the disclaimer requirement.

REQUIREMENT FOR INFORMATION

The Examining attorney requested that Applicant explain whether "2" or "2 GINGERS" has any meaning or significance in relation to Applicant's goods or in the industry in which the goods are manufactured or provided. The Examining Attorney further asked that Applicant state whether the number "2" in Applicant's Mark indicates an amount or measurement of ginger in Applicant's whiskey. As discussed above, the terms "2" and "2 GINGERS" have no meaning or significance in relation to Applicant's whiskey or to whiskey in general. Rather, "2 GINGERS" communicates the fictional branding story of two lively, red-headed Irish women, who are depicted on bottles of Applicant's whiskey. Furthermore, the number 2 does not indicate any amount or measurement of ginger in Applicant's whiskey as Applicant's whiskey does not contain any ginger.

Based on the foregoing, Applicant respectfully requests that this application be published for opposition.

EXHIBIT C

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Respondent: BUGLISI RECOBS GROUP LLC
Application No.: 86415114
Mark: MISTER GINGER

JIM BEAM BRANDS CO.,

Opposer

v.

BUGLISI RECOBS GROUP LLC,

Applicant

**AMENDED ANSWER WITH
COUNTERCLAIM**

**Opposition No. 91223497
Serial No. 86/415,114**

Applicant BUGLISI RECOBS GROUP, LLC (“Applicant” or “BRG”), in response to the opposition filed by Opposer JIM BEAM BRANDS CO. (“Opposer”) (the “Opposition”), by and through its undersigned counsel hereby answers the Opposition as follows:

ANSWER

1. Responding to paragraph 1 of the Opposition, BRG admits that it is a limited liability company, and admits that it is located at 189 Montclair Avenue, Montclair, New Jersey 07042.

2. Responding to paragraph 2 of the Opposition, BRG admits that on October 5, 2014, it filed Application Serial No. 86/415,114 (the “Application”) for the mark “MISTER GINGER” (“Applicant’s Mark”) for the “alcoholic beverages, namely, flavor-infused whiskey; blended whisky; bourbon whisky; malt whisky; whiskey; whisky,” on an intent to use basis.

3. Responding to paragraph 3 of the Opposition, BRG is without knowledge or information to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

1 4. Responding to paragraph 4 of the Opposition, BRG is without knowledge or information
2 to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

3 5. Responding to paragraph 5 of the Opposition, BRG is without knowledge or information
4 to form a belief as to the truth of the allegations contained therein.

5 6. Responding to paragraph 6 of the Opposition, BRG is without knowledge or information
6 to form a belief as to the truth of the allegations contained therein, and on that basis denies them.
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8 7. Responding to paragraph 7 of the Opposition, BRG admits that it filed its "MISTER
9 GINGER" mark on October 5, 2014, on an intent to use basis, subject to the clarification that the
10 application for registration included "flavor-infused whiskey; blended whisky; bourbon whisky;
11 malt whisky; whiskey; whisky."
12

13 8. Responding to paragraph 8 of the Opposition, BRG is without knowledge or information
14 to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

15 9. Responding to paragraph 9 of the Opposition, BRG admits that it does not currently use
16 the "MISTER GINGER" mark in connection with the goods for which it seeks registration; admits
17 that the business appears to still be in the development phase; denies that Exhibit C is a true and
18 correct copy of the Applicant's website, www.buglisirecobsgroup.com, at the present date.
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20 10. BRG denies the allegations contained in paragraph 10 of the Opposition.

21 11. BRG denies the allegations contained in paragraph 11 of the Opposition.

22 12. BRG denies the allegations contained in paragraph 12 of the Opposition.

23 13. BRG denies the allegations contained in paragraph 13 of the Opposition.
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Opposer's Prayer for Relief

BRG denies that Opposer is entitled to any of the relief requested in its prayer for relief.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

14. As and for a separate Affirmative Defense, Applicant BRG alleges that the Opposition fails to state facts sufficient to constitute a cause of action against BRG and upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

15. As and for a separate Affirmative Defense, Applicant BRG alleges that there is no likelihood of confusion, mistake, or deception between BRG's mark and Opposer's alleged trademark as to association, connection, sponsorship, endorsement, or approval of Opposer.

THIRD AFFIRMATIVE DEFENSE

16. Opposer does not have trademark rights in MISTER GINGER.

FOURTH AFFIRMATIVE DEFENSE

17. As and for a separate Affirmative Defense, Opposer lacks standing to bring one or more of the claims alleged against Applicant BRG.

FIFTH AFFIRMATIVE DEFENSE

18. As and for a separate Affirmative Defense, Applicant BRG alleges that the Opposition is uncertain, ambiguous, and unintelligible.

SIXTH AFFIRMATIVE DEFENSE

19. As and for a separate Affirmative Defense, Applicant BRG alleges that it has suffered damage by reason of Opposer's conduct.

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SEVENTH AFFIRMATIVE DEFENSE

20. As and for a separate Affirmative Defense, Applicant BRG alleges that it will not infringe, has not infringed, does not infringe (either directly or indirectly), and will not become liable for any purported trademark rights of Opposer.

EIGHTH AFFIRMATIVE DEFENSE

21. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because the trademark registrations and any derivative claims of infringement, separately and collectively, constitute misuses of the trademarks and misapplication of the law and statutes on which they are based.

NINTH AFFIRMATIVE DEFENSE

22. As and for a separate Affirmative Defense, Opposer's claims are barred to the extent that Opposer claims rights to elements of its products that are not protectable by trademark.

TENTH AFFIRMATIVE DEFENSE

23. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because the allegedly protectable features or characteristics of the subject trademark are functional.

ELEVENTH AFFIRMATIVE DEFENSE

24. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because any alleged association with Opposer's trademark rights is *de minimus*.

TWELFTH AFFIRMATIVE DEFENSE

25. As and for a separate Affirmative Defense, Opposer's claims fail, in whole or in part, because there is virtually no similarity in the products offered, no associated commercial impression, and the marks apply wholly distinct connotations to the word GINGER.

THIRTEENTH AFFIRMATIVE DEFENSE

1 26. As and for a separate Affirmative Defense, Opposer has no claim of priority of use in the
2 MISTER GINGER mark in connection with any products, let alone "flavor-infused whiskey;
3 blended whiskey; bourbon whiskey; malt whiskey; whiskey; whisky.

4 **FOURTEENTH AFFIRMATIVE DEFENSE**

5 27. In a written response to an office action issued on February 28, 2011 in connection with
6 Opposer's application to register the mark "2 GINGERS", with respect to an Irish whiskey,
7 Opposer submitted numerous statements of fact and relied upon numerous statements of law which
8 are adverse to Opposer's position in the instant opposition action.
9

10 28. Opposer should be estopped from taking any such position or positions adverse to its
11 previous submissions and should likewise be estopped from averring any fact or facts contrary to
12 those previously submitted by Opposer to the Trademark Trial and Appeal Board.
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14 **AS AND FOR A COUNTERCLAIM AND, IN THE ALTERNATIVE**

15 29. Applicant repeats and realleges the facts set forth in paragraphs 1 through 28, above.

16 30. "Applicant" Buglisi Recobs Group, LLC seeks dismissal of the "Opposer" Jim Beam
17 Brands Co's opposition action based in large part upon facts and law conceded and affirmatively
18 pled by Opposer in a formal response to an Office Action (hereinafter the "Office Action"), issued
19 on February 28, 2011 in connection with Opposer's application to register its mark "2 Gingers."
20

21 31. The Office Action sought to have Opposer disclaim with word ginger or gingers.

22 32. In response to the Office Action, Opposer relied upon precedent to the effect that, "doubts
23 concerning the descriptiveness of a mark should be resolved in favor of the Applicant during ex
24 parte prosecution" (emphasis supplied), and went on to submit statements of fact and law to the
25 Trademark Trial and Appeal Board including but not limited to the following:
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1 (a) "Applicant's [Opposer in the instant action], whiskey does not contain
2 ginger and is not ginger flavored;"

3 (b) "The term 'GINGER' is not commonly used to describe whiskey (in fact,
4 based on government regulations, whiskey cannot contain flavor additives such as ginger);"

5 (c) "The term 'GINGERS' cannot be descriptive of an ingredient or flavor of
6 whiskey."

7
8 (d) "Even when the '2 GINGERS' word mark used on its own and apart from
9 the label, consumers are likely to associate the term 'GINGERS' in [Opposer's] mark with
10 people who have red hair and not to ginger flavoring or to a ginger root. The work 'ginger'
11 when used to refer to the flavor or to a ginger root is always used in the singular form—even
12 when referring to a given quantity of ginger.... Accordingly, based on common uses, a person
13 encountering the [Opposer's] mark would assume the word 'GINGERS' refers to people with
14 red hair and not to Ginger flavoring. This is particularly true because [Opposers] whiskey is
15 an Irish whiskey and, as noted above, the term 'GINGERS' is often associated with red-haired
16 people from Ireland."

17
18 (e) "Consumers of [Opposer's] whiskey are also unlikely to ascribe any
19 descriptive meaning to [Opposer's] use of the term 'gingers' in [Opposer's] mark because
20 'whiskey' does not contain ginger or ginger flavoring. Significantly, the addition of such
21 flavoring to whiskey is not permitted under U.S. law (or Irish law, for that matter)."

22
23 (i) Pursuant to 27 C.F.R. Section 5.22, whiskey is legally defined as an
24 alcohol distillate from a fermented mash of grain produced at less than 190 proof in such
25 manner that the distillate possesses the taste, aroma and characteristics generally attributed to
26 whiskey, stored in oak containers.... and bottled at not less than 80 proof."

1 (ii) "C.F.R. Section 5.22(b) Irish whiskey must also be a product of
2 Ireland..."

3 (iii) "U.S. law specifies that 'the addition of any coloring, flavoring, or
4 blending materials to any class and type of distilled spirits... alters the class and type thereof
5 and the product shall be appropriately redesignated.' 27 C.F.R. Section 5.23 (a)(1)."

6 (iv) Accordingly, whiskeys that contain coloring, flavoring or other
7 blended materials are no longer considered 'whiskey' under U.S. law. Instead, such spirits are
8 classified as 'flavored whiskey' and must be labeled as such. See 27 C.F. R. Section 5.22(j)."

9 (f) "The distinction between 'whiskey' and 'flavored whiskey' is further
10 supported by the Trademark Offices ID Manual, which calls for whiskey to be identified as
11 either 'whiskey' or 'alcoholic beverages', namely, 'flavor-infused whiskey'accordingly,
12 while ginger may be descriptive of ginger-infused alcoholic beverages, it is not descriptive of
13 [Opposer's] whiskey."
14

15 (g) "In an effort to distinguish its product from the Trademark Offices example
16 of a ginger flavored whiskey named Revel Stoke, Opposer stated, "Revel Stoke clearly
17 advertises and labels its product as being a 'spiced whiskey'because Revel Stoke is a spiced
18 Canadian flavored-whiskey, this reference does not show use of ginger flavoring in connection
19 with [Opposer's] goods, namely, whiskey.
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21 (h) "Flavor infused whiskey is not the same thing as whiskey. They are two
22 different and distinct products, and are as unrelated as wine and wine coolers or vodka and
23 gin."
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1 (i) “Consumers who encounter [Opposer’s] mark will view the term
2 ‘GINGERS’ as being suggestive of Irish people and culture and to the good times that can be
3 had while enjoying whiskey.”

4 (j) “There is no evidence that consumers refer to or believe ‘ginger,’ much less
5 ‘GINGERS,’ is descriptive of whiskey.”
6

7 (k) “Consumers of [Opposer’s] goods are sophisticated purchasers and would
8 know the difference between whiskey and a flavor-infused whiskey. While whiskey can be
9 used in mixed drinks, it is very flavorful and often enjoyed on its own—either straight up or
10 on the rocks. Whiskey is a complex alcoholic beverage that has a very distinctive flavor
11 depending on where the whiskey is distilled. For example, Irish whiskey tends to be sweeter
12 than scotch whiskey. Accordingly, people who purchase whiskey are very mindful of the
13 distilling process and location of the distillery when deciding which whiskey to purchase.
14 Consumers of [Opposer’s] goods are very selective and conscientious when making purchasing
15 decisions. They would quickly note the difference between a whiskey and a flavor infused
16 whiskey. In particular, they would recognize that [Opposer’s] whiskey does not contain any
17 added flavoring and, therefore, would never ascribe a descriptive meaning to the term
18 ‘GINGERS’ in [Opposer’s] mark.”
19
20

21 (l) “There is no evidence that the industry involved in the manufacture,
22 distribution or sale of whiskey uses the term ‘ginger’ much less ‘GINGERS,’ descriptively or
23 believes the term to be descriptive.”
24

25 (m) “Moreover, the use of the term ‘GINGER’ in [Opposer’s] mark, does not
26 preclude the use of ordinary descriptive terms needed by competitors to properly describe their
27 own goods [Cites Omitted]. The public policy behind the descriptiveness doctrine is intended
28

1 to ensure that there is no competitive need for a term in the market place. While [Opposer]
2 uses the term 'GINGERS' to specifically identify itself as a source of its whiskey, competitors
3 have a virtually limitless number of merely descriptive words to truthfully describe their own
4 goods, including, among others, 'whiskey,' 'distilled spirits,' 'flavor-infused whiskey'."

5 33. The alcoholic beverage Applicant will market under the mark "Mister Ginger," should
6 registration be permitted, is a whiskey based product infused with ginger. It is not a "whiskey,"
7 as defined by Opposer and does not even contain "Irish whiskey" as defined by Opposer.
8

9 34. In the event that Opposer's instant action is not dismissed, Applicant submits that the
10 registration of Opposer's trademarks should be cancelled as the same are deceptively
11 misdescriptive.
12

13 35. Unless Opposer's mark for its Irish whiskey and Applicant's mark for its ginger flavored
14 whiskey product are found to be sufficiently distinct to avoid confusion in the marketplace, any
15 perceived confusion would result not from Applicant's use of the generic term "ginger," which is
16 a significant ingredient in Applicant's product, but rather from Opposer's deceptively
17 misdescriptive use of the term and its concomitant refusal to disclaim the term "ginger" (except as
18 to the mark, "big ginger" with respect to which such a disclaimer was made).
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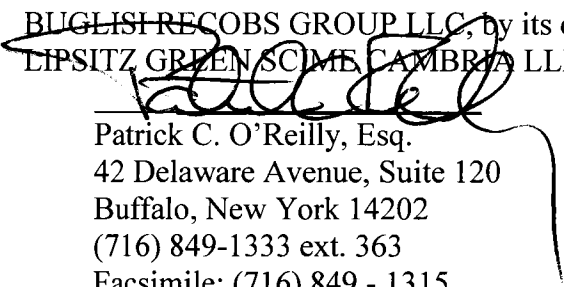
20 36. Applicant would be caused significant damage were it not to be permitted to use the said
21 generic term within its trademark and in the marketing of its product.
22

23 WHEREFORE, Applicant BRG requests the judgment of this Board that it deny the
24 Opposition against it, or in the alternative cancel Opposer's marks thereby making Opposer's
25 action moot, grant registration of Application Serial No. 86/415,114, and award Applicant BRG
26 its costs in defending this action, together with its reasonable attorneys' fees, and such other and
27 further relief as this Court deems just and equitable.
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1 DATED: March 17, 2016

2 Respectfully submitted,

3 BUGLISI RECOBS GROUP LLC, by its counsel
4 LIPSITZ GREEN SCIME CAMBRIDGE LLP

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